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| 10/624,209 | 07/22/2003 | Ronald Wrenholt | 20030229.ORI | 7059 |
| 23595 | 7590 | 11/24/2004 | EXAMINER | |
| NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402 | | | WOODS, ERIC V | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2672 | |

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,209

Applicant(s)

WRENHOLT ET AL.

Examiner

Eric V Woods

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

1. The drawings are objected to because the box next to element 16 in Fig. 2 is not labeled. In the specification, this box is labeled as asking the user a yes or no question. Clearly it should be labeled as a separate step. Further, the shading in the boxes for Fig. 2 renders the text in the boxes illegible, and the drawings must be changed so that all text is clearly readable in all the boxes. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: the term "institutional computer" is utilized. This terminology is not accurate – "institutional" refers to what kind of entity owns the computer, where it is very clear from applicant's specification that an "institutional" computer is merely a personal computer of some kind. Applicant did not state that applicant was acting as his own lexicographer. Further, even if applicant elects to act as his own lexicographer, applicant cannot arbitrarily redefine terminology far from the standard grammatical and etymological basis from the term, which is not the term applicant uses. (See "American Heritage College Dictionary", most recent edition.)

Appropriate correction is required.

3. The disclosure is objected to because there is an essential step missing. Applicant recites that the system asks the user if an image should be replaced (after step 16, on pg. 6 of the specification), but this essential step is not numbered in the specification. This step must be numbered and corrected in the specification as well as in the drawings as discussed above.

Claim Objections

4. Claim 1 is objected to because of the following informalities: the term "institutional computer" is utilized. This terminology is not accurate – "institutional" refers to what kind of entity owns the computer, where it is very clear from applicant's specification that an "institutional" computer is merely a personal computer of some kind. Applicant did not state that applicant was acting as his own lexicographer.

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Further, even if applicant elects to act as his own lexicographer, applicant cannot arbitrarily redefine terminology far from the standard grammatical and etymological basis from the term, which is not the term applicant uses. (See "American Heritage College Dictionary", most recent edition.)

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prepress (Prepress Technology Reports, "Open Prepress Interface (OPI)")(Prepress) in view of Lavery et al (US 2002/0191213 A1)(Lavery).

As to claim 1,

A method for producing publication pages containing images using a system that includes an institutional computer having desktop publishing software and connected to the Internet, a production computer system having a plurality of images stored thereon as high-resolution image files, and a printer connected to said production computer system (Prepress pgs. 1 and 2; illustration on pg. 7, showing printing unit, desktop computer / workstation, and image server. Lavery shows a website on computer 304 in Fig. 3 (see 0033, 0038-0041)), said method comprising the steps of:

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a. Using the institutional computer to open an image box on a document page and initiate a request for an image stored as a high-resolution image file on said production computer system, said request comprising a URL with unique identifier (Clearly, step 2 – “place photos or other high resolution graphics” – meets this recited limitation.

Prepress teaches OPI for displaying low-resolution versions of high-resolution images on screen (pg. 2) after the high-resolution photos are placed on the screen. Lavery teaches Internet methods in 0038, 0040, 0046, etc. It would be obvious to one of ordinary skill in the art that any website hosted and available over the Internet would utilize the HTTP protocol, in which all resource locations are specified using URLs. Each individual, static element stored on a server has a unique location, thus meeting the recited limitation of “URL with unique identifier.”);

b. Selecting an image file from the plurality of high-resolution image files stored on said production computer system and downloading from said production computer system to said institutional computer a low-resolution version of the selected image file (The preview image is taught in Prepress pg. 2, bottom of the page. On pg. 6, Prepress teaches that their product generates low-res previews by using a remote computer, shown as element 1 in the illustration on pg. 7. Clearly, the “color prepress workstation” – element 2 – gets the “callout image” (see bottom of pg. 2) – that is, the low-resolution preview image – from element 1.);

c. Placing said low-resolution version of the selected image file in the image box of the document page (More importantly, Prepress teaches that low-resolution versions of

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images are manipulated in page layout software (pg. 2 again, specifically step 2; further, see the process mapped out on pgs. 3-7 and the illustration on pg. 7));

d. Transferring to the production computer system the document page; (see pg. 2, the listed process, where step 3 teaches this; the "production computer system" consists of the imagesetter, which has OPI interpreter software on it, which clearly acts as the production computer system.) and

e. Automatically replacing said low-resolution version of the selected image file inserted into the image box of the document page with the corresponding high-resolution image file (pg. 2, step 4).

Reference Prepress teaches all the limitations of the claim except transmission of the document page over the Internet, although the document elements are transmitted over a LAN (local area network). Reference Lavery teaches in Fig. 3 the use of a website viewed on a client terminal (304) to edit, modify, and send page and image files (see 0030-0031, especially 0033) (see detailed notes for each step of the method rejection above; further, unique URLs are inherent to the HTTP protocol and Internet-hosted static image files, as they would be on such a server). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the previewed images of Prepress with the website of Lavery, since Lavery teaches that it is an improvement over previous OPI solutions (see 0031-0033 in the Background / Prior Art section of Lavery).

As to claim 2,

The method of claim 1 further including the step of cropping said low-resolution version.

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(Prepress pg. 3, "OPI supports all the cropping and sizing commands issued in the page markup program." Bottom of pg. 3, Quark and Adobe page creation software are both mentioned. Applicant recites both in applicants' specification – pg. 6, lines 5-10. Only the primary reference is utilized, so no separate combination or motivation is required; that of the parent claim is used herein by reference).

As to claim 3,

The method of claim 2 wherein any cropping of said low-resolution version is retained when the low-resolution version is automatically replaced by the corresponding high-resolution image file. (Prepress pg. 11, middle of the page, "...the preview image can be cropped ... from Quark or Pagemaker, and the high-res image will reflect those manipulations when imaged..." (Ellipses added). The term "imaged" here refers to when the final images are sent to the imagesetter (see step 4, pg. 2). Only the primary reference is utilized, so no separate combination or motivation is required; that of the parent claim is used herein by reference).

As to claim 4,

The method of claim 1 further including the step of scaling said low-resolution version (Prepress pg. 3, "OPI supports all the cropping and sizing commands issued in the page markup program." Bottom of pg. 3, Quark and Adobe page creation software are both mentioned. Applicant recites both in applicants' specification – pg. 6, lines 5-10. Only the primary reference is utilized, so no separate combination or motivation is required; that of the parent claim is used herein by reference.).

As to claim 5,

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The method of claim 4 wherein any sizing of said low-resolution version is retained when the low-resolution version is automatically replaced by the corresponding high-resolution image file. (Prepress pg. 11, middle of the page, "...the preview image can be cropped, scaled, or rotated ... from Quark or Pagemaker, and the high-res image will reflect those manipulations when imaged..." (Ellipses added). The term "imaged" here refers to when the final images are sent to the imagesetter (see step 4, pg. 2). Only the primary reference is utilized, so no separate combination or motivation is required; that of the parent claim is used herein by reference.).

As to claim 6,

The method of claim 1 wherein said document page is transferred to the production computer system via the Internet.

Reference Prepress teaches all the limitations of the claim except transmission of the document page over the Internet, although the document elements are transmitted over a LAN (local area network). Reference Lavery teaches in Fig. 3 the use of a website viewed on a client terminal (304) to edit, modify, and send page and image files (see 0030-0031, especially 0033). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the previewed images of Prepress with the website of Lavery, since Lavery teaches that it is an improvement over previous OPI solutions (see 0031-0033 in the Background / Prior Art section of

As to claim 7,

The method of claim 1 further including the step of printing at least one copy of the document page after the corresponding high-resolution image file has been substituted

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for said low-resolution version. (Prepress pg. 16 and the figure on that page – the “Panther” program used with a print server, which *prima facie* prints after the image modification is done –also element 4 in the illustration on pg. 7 is a printer. Only the primary reference is utilized, so no separate combination or motivation is required; that of the parent claim is used herein by reference.)

Conclusion

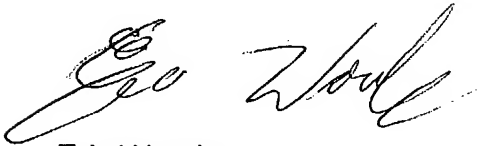
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US PGPub 2002/0145614 by Van Valer and US Patent 5991783 to Popa et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric V Woods whose telephone number is 703-305-0263. The examiner can normally be reached on M-F 7:30-5:00 alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on 703-305-4713. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

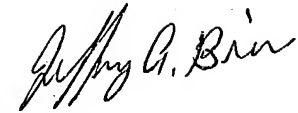
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in cursive script, appearing to read "Eric Woods".

Eric Woods

November 15, 2004

A handwritten signature in cursive script, appearing to read "Jeffery A. Brien".
JEFFERY BRIEN
PRIMARY EXAMINER